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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/336,462	06/18/1999	ROLF STEIGER	ICH-286	7675

25230 7590 02/09/2006

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EXAMINER

SCHWARTZ, PAMELA R

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 02/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/336,462

Applicant(s)

STEIGER, ROLF

Examiner

Pamela R. Schwartz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5, 8, 9 and 11-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 8, 9, and 11-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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1. Claims 8 and 11 depend from a canceled claim. For examination, they are treated as if dependent on claim 1.
2. Claim 1 is confusing because it is unclear if "and further includes" refers to the ink receiving layer or to the inorganic oxide. The claims should be clarified. For purposes of examination, they have been treated as if the phrase refers to the inorganic oxide.

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-3, 5, 8, 9, 11-19 and 21 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 6,156,419 in view of Malhotra (5589277).

Brugger et al. claim ink jet recording sheets including aluminum oxide modified with rare earth metals. Malhotra teaches a recording sheet containing lactic acid (see

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col. 18, lines 15-16), binders such as gelatin (see col. 23, lines 31-32) and inorganic oxides such as alumina or titania (see col. 29, lines 10-20). Malhotra also teaches the inclusions of brighteners, application of the coating via dip coating, and will inherently teaches a coating on both surfaces (if formed by dip coating) (see col. 29, lines 32-34, and line 43 through col. 30, line 21). The ink receptive layer on the back surface will perform an anti-curl function (col. 30, lines 55-56). Malhotra teaches the inclusion of an additive hydroxy acid, including aliphatic hydroxycarboxylic acids, in an ink jet recording medium to obtain a medium that has rapid ink drying times, that enables precipitation of a dye from the ink, that is useful in a process including microwave drying and that exhibits reduced curl subsequent to being imaged. It would have been obvious to one of ordinary skill in the art to utilize such an additive in the recording layer of the medium of Brugger et al. in order to obtain the advantages set forth above.

4. Claim 20 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 6,156,419 in view of Malhotra (5589277) as applied to claims 1-3, 5, 8, 9, 11-19 and 21 above, and further in view of Floegel et al. (US 6284339), Uemura et al. (US 6153305) or Kasahara et al. (6,165,606). Floegel et al. (col. 4, lines 22-26), Uemura et al. (col. 11, lines 46-48) and Kasahara et al. (col. 15, lines 60-64) teach anti-curl layers. Since these layers are well known in the art, inclusion of such a layer on the medium of the Brugger patent would have been obvious to one of ordinary skill in the art.

5. Claims 1, 5, 8, 9 and 11-21 rejected under 35 U.S.C. 103(a) as being unpatentable over Harasawa et al. (EP 614,771) in view of Inui et al. (5,573,582) and

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Fryberg et al. (WO 95/28285). The primary reference discloses a recording sheet having a colorant absorbing layer thereon (abstract). The layer may contain a hydroxy carboxylic acid (p.2, lines 24-26 and 38-48). The layer also contains alumina or alumina hydrate produced by hydrolysis of aluminum alkoxide and a binder such as polyvinyl alcohol (p. 3, lines 23-50). Inui et al. teach a specific alumina which is modified with small amounts other metals such as lanthanum in a production method that yields alumina of uniform size and free of coarse particles (see col. 8, lines 15-35). The reference teaches that the particles could be used as a coating filler in ink jet printing applications. Based upon this suggestion, it would have been obvious to one of ordinary skill in the art to use this modified alumina as the alumina of the primary reference because of the suggestion in the secondary art to do so and because of the advantage of avoiding the presence of coarse particles in the coating.

The rest of the claim limitations are considered to be obvious because they are conventional in the art. Fryberg et al. is cited because it supports the conventional nature of the dependent claim limitations. It teaches improving light fastness by inclusion of water soluble metal salts such as lanthanum nitrate (see p. 8, last paragraph through the paragraph on page 9 and the examples). Amounts of these salts are taught on page 10. Cross-linkers for the binder are disclosed at pages 12-13. Fillers are disclosed at page 13. Coating thickness, inclusion of one or more ink receiving layers, and inclusion of antistatic back layers are disclosed on page 17. Brightening agents and other conventional additives are taught on page 18.

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Since these materials and modifications are well known to one of ordinary skill in the art, it would have been obvious to include these for their well known purposes in the medium of the primary reference.

6. Claims 1-3, 8, 9 and 11-21 rejected under 35 U.S.C. 103(a) as being unpatentable over Tomioka et al. (JP 10217603) in view of Inui et al. (5,573,582) and Fryberg et al. (WO 95/28285). The primary reference discloses a recording medium comprising an ink receiving layer of alumina hydrate and acids, including lactic acid. Inui et al. teach a specific alumina which is modified with small amounts other metals such as lanthanum in a production method that yields alumina of uniform size and free of coarse particles (see col. 8, lines 15-35). The reference teaches that the particles could be used as a coating filler in ink jet printing applications. Based upon this suggestion, it would have been obvious to one of ordinary skill in the art to use this modified alumina as the alumina of the primary reference because of the suggestion in the secondary art to do so and because of the advantage of avoiding the presence of coarse particles in the coating.

The rest of the claim limitations are considered to be obvious because they are conventional in the art. Fryberg et al. is cited because it supports the conventional nature of the dependent claim limitations. It teaches improving light fastness by inclusion of water soluble metal salts such as lanthanum nitrate (see p. 8, last paragraph through the paragraph on page 9 and the examples). Amounts of these salts are taught on page 10. Cross-linkers for the binder are discloses at pages 12-13. Fillers are discloses at page 13. Coating thickness, inclusion of one or more ink

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receiving layers, and inclusion of antistatic back layers are disclosed on page 17.

Brightening agents and other conventional additives are taught on page 18.

Since these materials and modifications are well known to one of ordinary skill in the art, it would have been obvious to include these for their well known purposes in the medium of the primary reference.

7. Applicant's arguments with respect to claims 1-3, 5, 8,9,and 11-21 have been considered but are moot in view of the new ground(s) of rejection.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pamela Schwartz whose telephone number is (571) 272-1528.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PRSchwartz
February 6, 2006


PAMELA R. SCHWARTZ
PRIMARY EXAMINER